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DATE: May 13, 2009

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Please deliver this and the following pages to:

Examiner: **Michael Pham**
U.S.P.T.O. Group Art Unit: **2167**
Telecopier No.: **571-273-3924**
U.S. Serial No.: **10/647,058**
Client/Matter No.: **MSFT-1748**
Sender's Name: **David M. Platz**
Pages to Follow: **13**

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COVER MESSAGE:

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Attached hereto is/are the following documents:

- 1) Form 413A
- 2) Drafted Response for Discussion

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Applicant Initiated Interview Request Form

Application No.: 10/647,058 First Named Applicant: J. Patrick Thompson
 Examiner: Michael Pham Art Unit: 2167 Status of Application: Under Final

Tentative Participants:

(1) Attorney Platz (2) Examiner Pham
 (3) SPE (4) _____

Proposed Date of Interview: prior to 6/3/09 Proposed Time: after 12:00 EST AM/PM

Type of Interview Requested:

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated:

☒ YES ☐ NO

If yes, provide brief description: Proposed amendments

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rej Claims</u>	<u>1-11, 13-20, 23</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Continuation Sheet Attached

Brief Description of Argument to be Presented:

Discussion of proposed amendments and section 112, 101 and 103 rejections of the claims.

An interview was conducted on the above-identified application on _____
 NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature
David M. Platz
 Typed/Printed Name of Applicant or Representative
60,013

Examiner/SPE Signature _____

Registration Number, if applicable _____

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 33 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-0199 and select option 2.

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This listing of claims will replace all prior versions, and listings, of claims in the application.

Listing of Claims:

1. (Previously Presented) A computer system comprising:
a processor coupled to a computer readable storage medium, the computer readable storage medium including
instructions for an operating system, the operating system including
instructions for a database management program, the instructions for the database management program integrated with instructions for a file system, the file system configured to store file data as filestreams and the database management program is configured to generate Items from the file data and expose the Items to a shell of the operating system, the Items constituting discrete storable units of information;
the instructions for the database management program further including
instructions for generating a plurality of Item Folders that constitute an organizational structure for said Items, wherein the Item Folders are themselves Items and each Item Folder includes membership information identifying any relationships with Items;
the instructions for the database management program including instructions for generating a plurality of Categories that constitute an additional organizational structure for said Items, at least one of said Items belonging to at least one of the Categories, wherein each Item in a specific Category includes a common attribute that is described for that specific Category and Categories are themselves Items .
2. (Original) The computer system of claim 1 wherein an Item is a member of an Item Folder but is not owned by said Item Folder, such that the deletion of said Item Folder does not automatically result in the deletion of said Item.
3. (Original) The computer system of claim 1 wherein an Item is automatically deleted when it no longer belongs to any Item Folder.
4. (Original) The computer system of claim 1 wherein an Item, when it no longer belongs to any Item Folder, automatically becomes a member of a default Item Folder.

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5. (Original) The computer system of claim 1 wherein said Item is automatically deleted when it is a member of only one Item Folder and said Item Folder is deleted.

6. (Original) The computer system of claim 1 wherein said Item, when it is a member of only one Item Folder and said Item Folder is deleted, automatically becomes a member of a default Item Folder.

7. (Original) The computer system of claim 1 wherein each Item is a member of at least one Item Folder but is not owned by said Item Folder, such that the deletion of said Item Folder does not automatically result in the deletion of an Item.

8. (Original) The computer system of claim 1 wherein each said Item is itself automatically deleted when it no longer belongs to any Item Folder.

9. (Original) The computer system of claim 1 wherein each said Item, when each no longer belongs to any Item Folder, automatically become members of a default Item Folder.

10. (Original) The computer system of claim 1 wherein each said Item is itself automatically deleted when it is a member of only one Item Folder and said Item Folder is deleted.

11. (Original) The computer system of claim 1 wherein each said Item, when each is a member of only one Item Folder and said Item Folder is deleted, automatically become members of a default Item Folder.

12. (Canceled)

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13. (Previously presented) The computer system of claim 1 wherein a Category is defined by an Item property.

14. (Original) The computer system of claim 13 wherein one of said plurality of Categories is defined by an Item property, and only an Item comprising the Item property for a specific Category from among said plurality of Categories can be a member of said specific Category.

15. (Original) The computer system of claim 14 wherein an Item comprising the Item property for one of said plurality of Categories is automatically a member of that one of said plurality of Categories.

16. (Original) The computer system of claim 15 wherein an Item comprising one or more Item properties corresponding to one or more Categories of said plurality of Categories is automatically a member of each such Categories for said corresponding Item properties.

17. (Previously presented) The computer system of claim 1 wherein each of said plurality of Categories is defined by an Item property.

18. (Original) The computer system of claim 17 wherein each of said plurality of Categories is defined by an Item property, and only Items comprising the Item property for a specific Category from among said plurality of Categories can be members of said specific Category.

19. (Original) The computer system of claim 18 wherein each Item comprising the Item property for one of said plurality of Categories are automatically members of that one of said plurality of Categories.

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20. (Original) The computer system of claim 19 wherein all Items comprising one or more Item properties corresponding to one or more Categories of said plurality of Categories are automatically members of all such Categories for said corresponding Item properties.

21-22. (Canceled)

23. (Previously Presented) The computer system of claim 1, wherein the operating system is managed by a virtual machine manager.

24-36. (Canceled)

37. (Previously Presented) A method comprising:
executing an operating system, the operating system including a database management program, the database management program integrated with a file system;
storing, by the file system, file data;
generating, by the database management program, Items from the file data, wherein each Item of said plurality of items constitutes a discrete unit of information;
generating, by the database management program from the file data, Item Folders, the Item Folders constituting an organizational structure for said Items, wherein the Item Folders are a type of Item;
exposing, by the database management program, the Items and the Item Folders to a shell of the operating system.

38. (Previously Presented) The method of claim 37 wherein at least one Item is a member of an Item Folder but is not owned by said Item Folder, such that the deletion of said Item Folder does not automatically result in the deletion of said at least one Item.

39. (Previously Presented) The method of claim 38 wherein the at least one Item is automatically deleted when it no longer belongs to any Item Folder.

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40. (Previously Presented) The method of claim 38 wherein said at least one Item, when it no longer belongs to any Item Folder, automatically becomes a member of a default Item Folder.

41. (Previously Presented) The method of claim 38 wherein the at least one Item is automatically deleted when it is a member of only one Item Folder and said Item Folder is deleted.

42. (Previously Presented) The method of claim 38 wherein said at least one Item, when it is a member of only one Item Folder and said Item Folder is deleted, automatically becomes a member of a default Item Folder.

43. (Previously Presented) A computer-readable storage medium including processor executable instructions comprising:

instructions for an operating system, the operating system including instructions for a database management program, the instructions for the database management program integrated with instructions for a file system;

instructions for storing, by the file system, file data;

instructions for generating, by the instructions for the database management program, a plurality of Items, said Item comprising a discrete unit of information from the file data;

instructions for generating, by the instructions for the database management program, a plurality of Item Folders from the file data, the Item Folders including membership information identifying any relationships with Items and the Item Folders are themselves a type of Item;

instructions for generating, by the instructions for the database management program, a plurality of Categories from the file data, the Categories constituting an organizational structure for said Items;

instructions for exposing, by the database management program, the Items to a shell of the operating system.

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44. (Previously Presented) The computer-readable medium of claim 43 wherein at least one Item is a member of an Item Folder but is not owned by said Item Folder, such that the deletion of said Item Folder does not automatically result in the deletion of said Item.

45. (Previously Presented) The computer-readable medium of claim 44 wherein the at least one Item is automatically deleted when it no longer belongs to any Item Folder.

46. (Previously Presented) The computer-readable medium of claim 44 wherein said at least one Item, when it no longer belongs to any Item Folder, automatically becomes a member of a default Item Folder.

47. (Previously Presented) The computer-readable medium of claim 44 wherein the at least one Item is automatically deleted when it is a member of only one Item Folder and said Item Folder is deleted.

48. (Previously Presented) The computer-readable medium of claim 44 wherein said at least one Item, when it is a member of only one Item Folder and said Item Folder is deleted, automatically becomes a member of a default Item Folder.

49-60. (Canceled)

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REMARKS

Claims 1-11, 13-20, 23, and 37-48 are pending in the application. Claims 1-11, 13-20, 23, and 37-48 stand rejected. Applicants request further review and examination in view of the following remarks.

Related Co-pending Application with Allowable Subject Matter

Applicants advise the Examiner that notice of allowances in related U.S. Applications Nos. 10/646,645, 10/646,941, 10/646,646, and 10/646,580 have been received. Applicants advise the Examiner to check the file histories of the foregoing related cases.

Claim Rejections – 35 USC § 101

Claims 37-42 stand rejected under 35 U.S.C. § 101 as allegedly directed towards non-statutory subject matter. The Office Action states that a claim must be tied to a machine or transform underlying subject matter into a different state in order to qualify as a patentable process. (Office Action at p. 2-3). Applicants submit claims 37-42 are sufficiently tied to a machine to satisfy 35 U.S.C. § 101.

The Federal Circuit's recent *Bilski* decision did not elaborate on the 'machine' prong of the Machine or Transformation test, however it is clear from *Bilski* and prior cases that a process is sufficiently 'tied' to a machine when the machine imposes meaningful limits on the scope of the claim. *Id.* at 962. Or put another way, a claim is patentable when a machine is needed to carry out the claimed process. See, e.g., *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *In re Comiskey*, 2009 U.S. App. LEXIS 400 (Fed. Cir. Jan. 13, 2009); *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2D (BNA) 1545 (Fed. Cir. 1994) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999). In these cases the courts held that processes that implicitly or explicitly require machines are patentable. In *State Street Bank* the claim was directed towards a processing system that takes data representing discrete dollar amounts through a series of mathematical calculations to determine a final share price. The *State Street* Court held that the claim satisfied section 101 because, "[g]iven the complexity of [the]

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calculations, a computer or equivalent device [was] a *virtual necessity to perform the task.*"
State Street Bank, 149 F.3d at 1371 (emphasis added).

Furthermore, the Federal Circuit has found that claims that implicitly require machines are patentable. In *AT&T* the claim recited in part:

generating a message record for an interexchange call
between an originating subscriber and a terminating subscriber,
and

including, in said message record, a primary
interexchange carrier (PIC) indicator having a value which is a
function of whether or not the interexchange carrier associated
with said terminating subscriber is a predetermined one of said
interexchange carriers.

The claim above does not positively recite the use of a machine and the *AT&T* Court stated that such limitations are irrelevant to a 101 inquiry. More specifically, the court stated that such structural inquiry was unnecessary and reflects a misunderstanding of the law. *See, e.g., AT&T Corp.*, at 1359. Instead of determining whether a machine was positively recited by the claim, the court stated that the ultimate issue always has been whether the claim as a whole is drawn to statutory subject matter. *Id.* at 1359.

Turning to the language of the claims, claim 37 recites in part:

executing an operating system, the operating system
including a database management program, the database
management program integrated with a file system;
storing, by the file system, file data; ...and
exposing, by the database management program, the
Items and the Item Folders to a shell of the operating system

Applicants submit that the claim satisfies at least the machine prong of the Machine or Transformation test because a machine is needed to performed the claimed process. Realistically, an operating system can not be 'executed' and file data can not be 'stored,' as understood by a person of ordinary skill in the art, without the use of a computer system such as the one described in FIG. 1. Accordingly, for at least this reason, Applicants respectfully request reconsideration of the 35 U.S.C. § 101 rejections of claims 37-42.

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Compliance with U.S.C § 132 and 37 CFR § 1.104(a)(2)

Applicants submit that the Examiner has failed to provide sufficient information such that the Applicant can judge the propriety of continuing prosecution in violation of 35 U.S.C § 132 and 37 CFR § 1.104(a)(2). Applicants have reviewed the Office Action and submit that it is difficult to provide a meaningful response because of the lack of specificity in the Office Action as to how any of the documents describe “instructions for an operating system, the operating system including instructions for a database management program” and “instructions for the database management program integrated with instructions for a file system.” Instead of explaining in detail how the Bristol reference teaches or suggests the claimed subject matter within the meaning of 35 U.S.C. § 103 the Examiner merely parenthetically cites certain portions of Bristol. The Examiner has failed to explain how the cited portions of Bristol show an operating system that includes an operating system or a database management program that is integrated with a file system. Without this information it is difficult for Applicants to provide a meaningful response or determine whether to continue prosecution. Such vague assertions do not comport with the standards of U.S.C § 132 and 37 CFR § 1.104(a)(2). Applicants submit that since the instant Office Action does not comport to the requirements of the law the Office Action must be withdrawn.

What follows is the most complete response possible given the vagaries of the Office action. Applicants respectfully request that any further Office Action comply with the specificity required by 35 U.S.C. § 132 and 37 CFR § 1.104(a)(2) so that the most meaningful response can be provided. In this regard, any further Office Action should contain the PTO’s view as to how the documents describe “instructions for an operating system, the operating system including instructions for a database management program” and “instructions for the database management program integrated with instructions for a file system.”

Claim Rejections – 35 USC § 103

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Claims 1, 37, and 43 stand rejected under 35 U.S.C. 103(a) over U.S. Patent No. 6,018,342 to Bristor in view of U.S. Patent No. 7,158,962 to Nelson. Applicants traverse these rejections.

Claim 1

Bristor does not teach or suggest an operating system that includes instructions for a database management program

The Office Action states that col. 7, line 51 and col. 8, lines 1-18 teach or suggest "instructions for an operating system, the operating system including instructions for a database management program." Applicants disagree. Col. 7, line 51 states "[b]y classifying user data is a history database according to symbols of the user data, the user data can be categorized automatically and in accordance with the content of the description of the user data." Col. 8, lines 1-18 discuss a window including history buttons 108 that can be used to categorize user data. Applicants submit that the cited portions of Bristor are irrelevant to the claimed subject matter. Specifically, nothing in the cited portion of Bristor teaches or suggest that an operating system *includes* instructions for a database management program. Col. 1, line 30 of Bristor makes a passing reference to the Unix operating system, however nothing in Bristor says that the database is a part of the operating system. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 1.

Bristor does not teach or suggest instructions for a database management program integrated with instructions for a file system

The Office Action states that col. 8, lines 41-50 teach or suggest "instructions for the database management program integrated with instructions for a file system." Applicants disagree.

Col. 8, lines 41-50 state in full:

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In the example of FIG. 1B, the only command which includes a component whose initial letter is "L" is the command "ls mystuff.*." Accordingly, the only item included in history menu 112L represents the command "ls mystuff.*."

To retrieve and re-enter the command "ls mystuff.*," the user selects the only item from history menu 112L as described more completely below. In response to the selection of the item by the user, the command "ls mystuff.*" is retrieved from a history database, which is described in greater detail below, and is processed as if the user had entered the command using conventional techniques.

Nothing in the cited portion of Bristol is remotely related to discussing a database management program that is integrated with instructions for a file system. Bristol is silent as to whether a database can be an integral part of a file system. In fact, Applicants have searched Bristol and submit that the term "file system" is completely absent from Bristol. Applicants submit that Bristol can not teach or suggest that claimed subject matter if it fails to complexly mention part of the claim language. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 1.

Insomuch as dependent claims 2-11, 13-20, and 23 depend directly or indirectly from claim 1 Applicants respectfully request reconsideration of the rejections of these claims.

Independent claim 37 recites "executing an operating system, the operating system including a database management program, the database management program integrated with a file system." Applicants submit that claim 37 defines over the cited art of record for at least similar reasons as claim 1. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 37.

Insomuch as dependent claims 38-42 depend directly or indirectly from claim 37 Applicants respectfully request reconsideration of the rejections of these claims.

Independent claim 43 recites "instructions for an operating system, the operating system including instructions for a database management program, the instructions for the database management program integrated with instructions for a file system." Applicants submit that claim 43 defines over the cited art of record for at least similar reasons as claim 1.

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Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 43.

Insomuch as dependent claims 44-48 depend directly or indirectly from claim 43 Applicants respectfully request reconsideration of the rejections of these claims.

CONCLUSION

Applicants request the Examiner reconsider the rejections and issue a Notice of Allowance of all the claims.

Date: DRAFT

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